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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91156321
Party	Plaintiff The Chamber of Commerce of the United States of America
Correspondence Address	William M. Merone Kenyon & Kenyon 1500 K Street N.W., Suite 700 Washington, DC 20005 UNITED STATES ekane@kenyon.com
Submission	Opposition/Response to Motion
Filer's Name	Erik C. Kane
Filer's e-mail	ekane@kenyon.com, tmdocketdc@kenyon.com
Signature	/Erik C. Kane/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE CHAMBER OF COMMERCE OF  
THE UNITED STATES OF AMERICA

*Opposer,*

v.

UNITED STATES HISPANIC CHAMBER  
OF COMMERCE FOUNDATION,

*Applicant.*

Opposition No.: 91/156,321

Serial No.: 78/081,731

**OPPOSER’S OPPOSITION TO APPLICANT’S AMENDED MOTION TO EXTEND  
TESTIMONY PERIOD OR TO SUSPEND THE PROCEEDING**

Opposer, The Chamber of Commerce of the United States of America, hereby opposes Applicant United States Hispanic Chamber of Commerce Foundation’s request to extend or suspend its testimony period. This case needs to move forward.

Applicant seeks to extend its testimony period—which opened seven months ago—so it can conduct further *discovery* of third parties under the guise of having issued “trial” subpoenas. This characterization of Applicant as seeking “discovery” is not mere hyperbole: the U.S. District Court for the Southern District of New York *has already held* that Applicant has improperly issued multiple “trial” subpoenas in an attempt to obtain third party discovery (leading the court to quash the document requests), and a review of the “trial” transcripts from the three third party depositions that have already taken place supports the inescapable conclusion that Applicant is fishing for material to use in this (and possibly a related)

proceeding. Applicant should therefore not be afforded yet more time to abuse the process, increase costs, and inconvenience third parties.

Moreover, even if Applicant was merely seeking true trial testimony (although the requests for document production Applicant served with its subpoenas belie that thought), an extension of Applicant's testimony period would still be unwarranted. Despite having *seven months* to put on its case, Applicant waited until the last minute and then noticed no less than ten third party depositions over the last four days of its testimony period, all evidently without even having consulted the third parties (let alone Opposer) as to their availability to appear on the dates and at the times indicated on the subpoenas.

Naturally, Applicant's last minute orchestration of deposition schedules went predictably awry as a result of third party witness unavailability (or unwillingness), and Applicant somehow now blames *Opposer* for the scheduling problems, even though Opposer was willing to appear at all ten depositions at the times and places as originally noticed by Applicant. Applicant, though, should not be able to create its own crisis and then demand an extension of time when it knew full well when it scheduled its four day deposition marathon (to be held in three cities on two coasts, nonetheless) that the proposed dates were unlikely to hold. The extension request should be denied.

**I. Applicant Is Inappropriately Seeking Third Party  
"Discovery" During Its Trial Testimony Period**

Applicant's self-serving contention that it is not seeking discovery flies directly in the face of the February 21<sup>st</sup> ruling of the U.S. District Court for the Southern District of New York, wherein the court *expressly held* that Applicant was improperly using the subpoena process to

obtain discovery.<sup>1</sup> *See* Ex. A, pp. 2-3 (Memorandum and Order issued in *The Chamber of Commerce of the United States of America v. United States Hispanic Chamber of Commerce Foundation, Order*, Misc. No. M-8-85 (S.D.N.Y. Feb. 21, 2008)). As District Court noted in its decision, Applicant was improperly seeking “relief”—that is to say, discovery—that was “not permitted by the TTAB at this time,” and the court further observed that Applicant had not petitioned the Board to change the schedule so as to reopen the discovery period (which request undoubtedly would have been denied for lacking “good cause”). *See id.*, p. 3, n.3. Thus, it is disingenuous for Applicant to suggest that Opposer’s efforts to quash the document requests were somehow improper (after all, its motion was *granted*), and it is flat out deceptive to intimate that those motions—which did not touch at all on the scheduled depositions—contributed in any way to the scheduling crisis in which Applicant later found itself.

To revisit the point, however, it is clear that the subpoenas Applicant issued were designed to solicit *discovery*. Through the subpoenas, Applicant sought broad categories of documents that Applicant had no way of knowing even existed (as Applicant had not interacted with the third parties before issuing the trial subpoenas, nor taken a discovery deposition). Further, Applicant requested that the third parties produce the requested documents up to a week *before* the start of the schedule “trial” deposition—conduct that the New York court found to be “a clear indication of [Applicant’s] intent” to obtain discovery for use at trial. *See* Ex. A, p. 2.

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<sup>1</sup> The U.S. District Court for the Southern District of New York was the only court to reach the issue of whether Applicant was seeking discovery. Contrary to Applicant’s assertions, the District Court for the Eastern District of Virginia *never addressed* the propriety of the subpoena. Rather, that court held that the motion to quash was moot because the third party in question had already produced documents in response to the first four document requests, and Applicant agreed on the record to withdraw the fifth document request, which request Applicant *admitted* sought discovery.

Courts have repeatedly prevent parties from using “trial” subpoenas in this way, including in Board proceedings. *See, e.g., McKay v. Triborough Bridge and Tunnel Authority*, 2007 WL 3275918, \*2, n.2 (S.D.N.Y. 2007) (“[W]hile the subpoena seeks the production of documents defendants *may* introduce as trial exhibits, the scope of the request is broad and clearly is designed for discovery, not last-minute trial needs.”) (citations omitted, emphasis in original); *Dodson v. CBS Broad.*, 2005 U.S. Dist. LEXIS 30126, 3-4 (S.D.N.Y. 2005) (“[Plaintiff’s] subpoena clearly seeks discovery, as is apparent from his having the subpoena returnable to his address in New Jersey at the present time, instead of to Judge Wood’s courtroom at the time of trial. Moreover, the scope of the request is broad and clearly is designed for discovery, not last-minute trial needs (such as for originals of documents where copies were produced in discovery and there is a need for the original at trial) ... Rule 45 trial subpoenas duces tecum may not be used ... as means to engage in discovery after the discovery deadline has passed.”); *Lie & Fung Ltd. v. L.W. Loyd Co.*, 143 U.S.P.Q. 117, 118-119 (E.D. Tenn. 1964) (“Rule 2.120 of the Trademark Rules of Practice requires the taking of discovery evidence prior to the taking of any testimony for the trial. If the subpoena duces tecum calls for documents and papers that are for discovery, then this part of the motion to quash is good.”); *see also McNerney v. Archer Daniels Midland Co.*, 164 F.R.D. 584, 588 (W.D.N.Y. 1995).

It is axiomatic, of course, that discovery may not be taken in a Board proceeding outside the discovery period, which here closed some *eighteen months* ago (in June 2006). *See, e.g.,* TBMP, §403.01 (“The discovery devices ... are available for use only during the discovery period.”); 37 C.F.R. § 2.120(a). Rather than petition the Board to reopen discovery, however, Applicant sought to engage in self-help by abusing the subpoena power. The New York court

was thus justified in holding that Applicant engaged in improper discovery, and Applicants arguments now to the contrary are unavailing.<sup>2</sup>

Moreover, Applicant's discovery efforts do not stop with the documents. As can easily be discerned from a review of the three third party "trial" depositions that Applicant has already taken, Applicant was clearly fishing for discovery. *See generally, e.g., Exhibits B, pp. 31-41 (Trial Testimony of Curtis Carlson of the Swedish-American Chamber of Commerce), C, pp. 23-26 (Trial Testimony of Melissa Brown of the U.S. Spain Chamber of Commerce), and D, pp. 17-20 (Trial Testimony of Mary Gianne-Singer of the French American Chamber of Commerce).* In fact, at one point, when it became clear that the subpoenaed witness could not readily provide an answer to the question, Applicant asked him *to look for more documents* and to report back:

MS. SLUSSER: Were members of the U.S.  
Chamber of Commerce attending  
Edays?")

THE WITNESS: I don't know.

...

WITNESS: I was there, but I don't know if any members of the United States Chamber of Commerce were there. However, there would be a way to get the answer. It would require us to go back and dig out files that are in a warehouse, and we probably have them, you know, the names of the people that signed up -- probably have. I don't know if we have it for sure.

Q If you could look for that, I'd appreciate it –

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<sup>2</sup> Applicant's suggestion that the use of Opposer's *internal* documents by Opposer's witnesses as trial exhibits during their trial testimony likewise constitutes improper "discovery" is nonsensical given that the documents were always in Opposer's possession and thus did not need to be "discovered." Further, it is worth noting that in the past month, Applicant has served Opposer with *seven* additional sets of document productions totaling thousands of pages, most of which were *external* documents.

A Uh-huh.

MR. MERONE: Excuse me. ...

I want to know the basis that requests the witness to look for documents in connection with this case, since your testimony period closes on Thursday.

MS. SLUSSER: On the same basis that it is continuing with his trial testimony.

(See Exhibit B, Depo. Swedish-American Chamber, 38:21-39:22).

Trial testimony is meant to be an orderly presentation of one's case and not a fishing expedition to uncover unknown facts. Applicant has no knowledge of what these third parties will say and it clearly is fishing for discovery—a situation that will only be worse in future depositions now that the New York court has quashed the requests for document production. (The Swedish-American Chamber had “voluntarily” produced documents before the motion to quash its subpoena was heard, thus providing Applicant with more information than it will have in any of the other scheduled “trial” depositions). As it did with its improper document requests, Applicant is using the subpoena power to conduct discovery—this time in the form of discovery depositions. The Board should not facilitate that process by extending the “testimony” period at this late date.

## **II. Applicant's Inability to Complete its Presentation of Third Party Testimony Does Not Provide “Good Cause” to Extend**

Applicant seeks to extend its testimony period for one simple reason: it has failed to act in a diligent manner when putting on its case in chief during the past seven months. As Applicant's scheduling “crisis” was a foreseeable problem strictly of its own making (and even without considering the fact that the testimony Applicant likely would offer would be strictly in

the nature of discovery, *see* pp. 5-6, *supra*), the Board should not extend the testimony period and this case should be allowed to move forward.

As the Board has explained, “a party moving to extend time must demonstrate that the requested extension of time *is not necessitated by the party’s own lack of diligence or unreasonable delay* in taking the required action during the time previously allotted therefor.” *TBMP*, §509.01(a) (emphasis added); *accord, e.g., Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (a party’s desire to conduct follow-up discovery held not to establish “good cause” for extending the discovery period where party seeking the extension did not serve initial discovery requests until late in the discovery period). Further, the Board has stated that it “will scrutinize carefully any motion to extend time, to determine whether the requisite good cause has been shown.” *TBMP*, §509.01(a) (internal quotes omitted).

Here, Applicant’s inability to complete its presentation of evidence during its seven-month testimony period was entirely the result of Applicant’s “unreasonable delay” in serving the third party subpoenas (Applicant does not claim, for example, that it only recently learned of the existence of these third parties) and its “lack of diligence” in pursuing discovery and then putting on its case. “Good cause” to extend the testimony period is therefore lacking, and the request should be denied.

**A. Applicant Unreasonably Delayed in Seeking the Third Party Testimony**

Applicant’s testimony period opened way back on July 31, 2007. Since then, Opposer has consented multiple times to extending Applicant’s testimony period, which has now been open for over seven months.<sup>3</sup> Prior to late-January, however, Applicant made no effort to put on

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<sup>3</sup> Tellingly, several of these extensions resulted from representations from Applicant’s lead (continued)



its case, at which time it noticed its three party or party-affiliated witnesses, whose depositions were scheduled for (and completed) in late-February. Those depositions had originally been noticed for September 2007, and at which time they presumably represented the sum total of Applicant's testimony evidence.

With a sudden burst of last-minute enthusiasm, however, Applicant served ten new third party subpoenas sometime during the week of February 11<sup>th</sup>, all requesting the production of documents by February 22<sup>nd</sup>, and setting all of the trial depositions to occur between February 25<sup>th</sup> and 28<sup>th</sup>, which were the last four days of Applicant's testimony period.<sup>4</sup> When setting the deposition dates, however, Applicant evidently did not once consult with the third parties (and certainly did not confer with Opposer) to inquire as to whether the last-minute scramble Opposer was seeking to orchestrate was even feasible. As originally scheduled, the deposition schedule for those four days looked as follows:

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counsel that she was unavailable for depositions until this time. This was also lead counsel's excuse to delay the 30(b)(6) deposition in the co-pending Cancellation proceeding. However, Applicant's lead counsel failed to show up for even one of the third party depositions. Rather, Applicant had other attorneys from Manatt Phelps' New York and Los Angeles offices take the depositions.

<sup>4</sup> Although copies of the subpoena were sent to Opposer by email after the close of business on Friday, February 8<sup>th</sup>, there is nothing to suggest that the third parties were served prior the following week.

<b>Date</b>	<b>Time</b>	<b>Location</b>	<b>Witness</b>
Feb. 25	9:00am	Washington, DC	United States - Mexico Chamber of Commerce
Feb. 25	1:00pm	Washington, DC	U.S.-Women's Chamber of Commerce
Feb. 26	9:00am	Washington, DC	American-Russian Chamber
Feb. 26	12:00pm	Washington, DC	Swedish-American Chambers of Commerce USA
Feb. 27	9:00am	Washington, DC	United States-Azerbaijan Chamber of Commerce
Feb. 27	9:00am	New York, NY	French American Chamber of Commerce In The United States
Feb. 27	12:00pm	New York, NY	Belgian-American Chamber of Commerce In The United States
Feb. 27	3:00pm	New York, NY	Argentine-American Chamber of Commerce
Feb. 28	9:00a	New York, NY	U.S./Austrian Chamber of Commerce
Feb. 28	10:30a	Los Angeles, CA	(party witness)
Feb. 28	12:00p	New York, NY	The Spain - U.S. Chamber of Commerce

On its face, this proposed schedule was clearly unworkable and improper (assuming that Applicant even *had* cleared it with the witnesses in advance). “A party may not take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.” *TBMP*, §703.01(c). Yet on at least two of the days, Applicant was proposing to offer simultaneous testimony in two cities (and on one day, on two *coasts*). Moreover, there was simply no possibility that the schedules of all ten of the third parties would somehow magically be clear so that a knowledgeable witness from each party could be available on the exact day, at the exact time, and in the exact place Applicant noticed, and Applicant knew that from the start. The

proposed “schedule” was never meant to be anything of the sort—it was merely intended to be a placeholder so that Applicant could request an extension when it predictably fell through.<sup>5</sup>

In its papers, Applicant does not explain why it is that it had to wait until mid-February to approach these third parties for testimony, given that its testimony period opened *back in July* and this case has been pending since April 2003. Moreover, Applicant cannot claim that it was somehow unaware of these parties prior to now (one of the third parties was even discussed during Opposer’s testimony), and it is notable that none of these parties were included on the original schedule that Applicant proposed back in August, before its testimony period was extended the first time to accommodate its supposed scheduling conflicts with other legal matters. Thus, the only conclusion that one can draw is that Applicant decided to include these third parties as witnesses at the very last minute, and did not leave any time in its schedule to coordinate their testimony. Thus the supposed “need” for an extension of which Applicant speaks was necessitated entirely by Applicant’s “own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor,” and thus cannot constitute the “good cause” necessary for granting the extension. *See TMBP*, §509.01(a).

**B. Opposer Was More Than Accommodating  
To Applicant’s Frenetic Trial Schedule**

In one of its many efforts to shift blame, Applicant claims that Opposer was somehow uncooperative in helping it meet its impossible trial schedule. That is simply not the case. From

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<sup>5</sup> And fall through it did, almost immediately. Of the ten subpoenaed third parties, five served written objections to Applicant, and several of them included compelling grounds for the invalidity of the subpoena (such as lack of service, improper parties, etc.). (See Exs. E-I). Most of the objections also indicated the third parties simply could not make the deposition dates on such short notice, as anyone could have clearly anticipated. (See e.g., Ex. F, American Russian; Ex. H, U.S.-Azerbaijan). Moreover, at no point did Applicant move to compel any of these third party witnesses to appeared at the noticed time and place.

the outset, Opposer let Applicant know that even though Opposer objected to the scheduled “trial” deposition on “discovery” grounds (*see* pp. 5-6, *supra*), it had cleared its schedule and was prepared to attend *each and every* deposition at the time and place as originally set in the subpoenas, even though that required double- (and in one case, triple-) tracking deposition coverage. *See, e.g.*, Exhibit J (communications sent by Opposer about the scheduling of the depositions and Opposer’s attendance).

In fact, when Applicant *re-noticed* the deposition of the Swedish-American Chamber of Commerce’s to take place in Los Angeles, California on February 25<sup>th</sup> (rather than in Washington, DC on Feb. 26<sup>th</sup>), Opposer agreed to accommodate the change, even though it was yet another blatant example of bi-coastal double tracking, and even though that meant sending counsel out to California much earlier than expected, thus making that person unavailable to cover the other noticed matters. Similarly, when Applicant cancelled the deposition of the French American Chamber of Commerce (*see* Ex. K, February 22, 2008 email string between Andrew Eliseev and Edward Colbert), and then, with less than 24 hours notice, put it back on the schedule (*see* Ex. L, February 26, 2008 email string between Andrew Eliseev and Erik Kane), Opposer again accommodated Applicant’s schedule, despite objecting to the insufficiency of the notice. Opposer similarly accommodated the last minute rescheduling of the U.S. Mexico Chamber deposition (which ultimately did not take place due to the third party’s schedule).

The only “example” Applicant gives of how Opposer supposedly failed to accommodate Applicant is the fact that Opposer would not consent to conduct its cross-examination of a witness by telephone, as is its rights. *See TBMP*, §703.01(h). To be sure, Opposer did not object to *Applicant* appearing by telephone, but Opposer should not have to put itself at a tactical disadvantage in order to accommodate Applicant’s lack of diligence in scheduling, especially

when Opposer was fully prepared (and had made plans) to appear at the time and place *noticed by Applicant* for the deposition.

**C. The Motion to Quash (Which Was Granted) Should Have Been Expected and Did Not Impact the Trial Schedule**

Finally, Applicant suggests—without any support—that Opposer’s motions to quash somehow affected the third parties’ attendance at the depositions, and thus again seeks to blame Opposer for Applicant’s inability to pull off the eleven deposition, three city, four day testimony marathon that Applicant tried to cram into the end of its schedule.<sup>6</sup> In actual fact, however, Opposer simply moved to quash the *duces tecum* portion of Applicant’s subpoenas as improper discovery.<sup>7</sup> Opposer made it abundantly clear to all of the third parties that its motions would not address the *ad testificandum* portion of the subpoenas. *See, e.g.*, Exhibit M (samples of letters that Opposer sent to third parties regarding the subpoenas and the filing of Opposer’s motion to quash).

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<sup>6</sup> Applicant is wrong when it suggests that Opposer interfered with Applicant’s ability to present its testimony by challenging Applicant in three different district courts. *See Appl. Mot.* at 6. First of all, Opposer only filed one proceeding in the New York court for the five subpoenas issued there. The District Court of the District of Columbia required separate identical filings for the four subpoenas issued there. Second, Applicant chose to triple track in three cities by issuing improper subpoenas from three different courts. Applicant cannot now argue it was improper for Opposer to challenge the propriety of such subpoenas simply because it requires adjudicating them in the three courts that issued those subpoenas.

<sup>7</sup> Applicant’s contention that Opposer should have approached the Board with its motion to quash rather than pursuing the matter in the courts is contrary to established practice. The district court that issues a subpoena in connection with a Board matter has the exclusive jurisdiction to resolve matters relating to that subpoena. *See* 35 U.S.C. § 24; *Luehrmann v. Kwik Kopy Corp.* 2 U.S.P.Q.2d 1303, 1306 n.3 (T.T.A.B. 1987); *see also* TBMP 404.03(a)(2)). In fact, the Board has made it clear that it will not resolve matters regarding subpoenas, nor will it issue protective orders limiting the scope of such subpoenas. *See e.g., In Re Application of Johnson & Johnson*, 59 F.R.D. 174, 176 (D. Del. 1973) (noting that the TTAB denied a motion for a protective order on the ground that “only the court issuing the subpoenas had the power to grant the relief sought.”)

The fact that seven of the ten depositions failed to go forward thus was not in any way the result of Opposer's actions. In fact, Applicant *solicited testimony* during the three depositions that did go forward that confirms that Opposer in no way interfered with the deposition process. See Exs. B, pp. 74-76, C, pp. 48-49, and D, pp. 64-65. The problem that Applicant had was that it attempted to take ten third party depositions (plus one of its own witness) during the last four days of its testimony period, and because it failed to give these third parties any advance notice (even though Applicant's testimony period opened *seven months ago*), it had no ability to accommodate the inevitable scheduling conflicts and objections raised by the various third parties. See generally Ex. E-I (collection of correspondence from third parties relating to deposition issues).

### **III. Applicant's Argument Related to The "Errata Sheets" is a Red Herring Designed to Shift Blame**

Applicant last excuse for why its testimony period should be extended is because it supposedly failed to receive "errata sheets" from Opposer's trial depositions. As Applicant admits, though Opposer provided Applicant with full, corrected transcripts *over six months ago*. *App. Br.*, p. 12. Thus, it is difficult to understand what exactly is Applicant's concern.

Indeed, under Board rules, "errata sheets" are not even permitted (*TBMP*, §703.01(n)), and in this case would have been irrelevant anyway as any and all of the relatively minor changes that were made to the testimony *were already reflected in the transcripts that Applicant received* back in September 2007. Further, Applicant fails to explain *why* its delay in serving the third-party subpoenas was somehow delayed by its receipt of the "errata" sheets that Applicant never

needed to send (but which Opposer provided as a courtesy nonetheless<sup>8</sup>). As can be seen from the third party depositions that have already been completed, Applicant never *once* referenced the testimony of any of Opposer's witnesses during its direct examination (let alone the "corrected" testimony). Moreover, Applicant never even *contacted* the third party witnesses prior to noticed their depositions. Thus, claims that it supposedly waited to receive "errata" sheets before "preparing" the witnesses to testify are absurd.

What this argument from Applicant underscores is that Applicant has no "good cause" for why it never sought to take the third party testimony (which, as noted already, is really just thinly veiled "discovery") until the very last minute. Thus, Applicant is attempting to find any excuse it can to shift the blame from where it properly belongs. At some point, though, Applicant has to take responsibility for its own actions. The motion to extend should be denied and this case should be allowed to be brought to a close.

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<sup>8</sup> Even though Opposer provided Applicant with full copies of the corrected transcripts back in September 2007 (in compliance with *TBMP*, §703.01(n)), when Applicant further asked for "errata" sheets, Opposer undertook the chore of generating separate pages showing the corrections by manually comparing the original transcript (which Applicant received in July 2007) with the corrected one (which Applicant received in September 2007)—a process that Applicant could have just as easily done.

#### IV. CONCLUSION

For the reasons set forth above, Applicant's motion to extend its testimony period or in the alternative to suspend the proceedings should be denied.

Respectfully submitted,

Date: March 12, 2008

/s/ Erik C. Kane  
Edward T. Colbert  
William M. Merone  
Erik C. Kane  
KENYON & KENYON LLP  
1500 K Street, N.W.; Suite 700  
Washington, D.C. 20005  
Tel.: (202) 220 – 4200  
Fax: (202) 220 – 4201

*Counsel for Opposer, The Chamber of Commerce of  
the United States of America*



## CERTIFICATE OF SERVICE

I hereby certify that the required number of copies of the foregoing *Opposer's Opposition To Applicant's Amended Motion To Extend Testimony Period Or To Suspend The Proceeding* was served on the parties or counsel on the date and as indicated below:

***By First-Class Mail (Postage Prepaid)***

Jill M. Pietrini  
Andrew Eliseev  
MANATT PHELPS & PHILLIPS, LLP  
11355 W. Olympic Boulevard  
Los Angeles, CA 90064-1614

Date: March 12, 2008

\_\_\_\_\_/s/ Erik C. Kane  
Edward T. Colbert  
William M. Merone  
Erik C. Kane  
KENYON & KENYON LLP  
1500 K Street, N.W.; Suite 700  
Washington, D.C. 20005  
Tel.: (202) 220 – 4200  
Fax: (202) 220 – 4201

*Counsel for Opposer, The Chamber of Commerce of  
the United States of America*

# Exhibit A

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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THE CHAMBER OF COMMERCE OF THE :  
UNITED STATES OF AMERICA, :

Opposer, : M-8-85

- v -

: MEMORANDUM AND ORDER

UNITED STATES HISPANIC CHAMBER OF :  
COMMERCE FOUNDATION, :

Applicant. :

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McKENNA, D.J.,

Opposer and Applicant are presently engaged in a proceeding before the United States Patent and Trademark Office Trademark Trial and Appeal Board ("TTAB"). Opposer moves for an order quashing five subpoenas duces tecum issued in this district to third parties.

Some features of procedure before the TTAB must first be summarized. Proceedings before the TTAB are "in large part" governed by the Federal Rules of Civil Procedure. (TTAB Manual of Procedure ("TBMP"), Sections 101.01, 101.02. See also 37 CFR, Ch. I, Part 2, § 2.116(a).)<sup>1</sup> The TTAB sets opening and closing dates for the taking of discovery. (TBMP Section 403.1.) The discovery period expired more than 18 months ago. (Opposer's Mem., Feb. 13, 2008, at 5.) The TTAB proceeding is now within the post-

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<sup>1</sup> Excerpts from the TBMP are annexed as Exhibit G to the Declaration of Brad Behar, dated February 13, 2008.

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discovery period during which Applicant may offer testimony (which is done before the TTAB by filing transcripts of depositions).<sup>2</sup>

Applicant has caused five subpoenas to be issued in this district pursuant to Fed. R. Civ. P. 45 dated February 8, 2008, for depositions to be held on February 27 and 28, 2008, and documents described in categories to be produced in advance, on February 22, 2008.

Opposer claims that the subpoenas seek discovery, prohibited by the TTAB rules. Opposer does not object to the oral depositions of representatives of the subpoenaed parties.

The document production portions of the subpoenas, however, appear to be an attempt to obtain discovery. They call for quantities of a number of descriptions of documents which it is really difficult to imagine being offered in evidence in bulk, and, more importantly and a clear indication of intent, they seek production of the documents not at, but in advance of, the depositions.

Applicant argues that Opposer does not have standing to bring the present motion and that this Court does not have jurisdiction over this dispute (Sheehan Letter to Court, Feb. 20, 2008, at 1), on the ground that "the Movant is not in the possession of the requested documents, and does not allege any

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<sup>2</sup> See Amended Stipulated Motion for Extension of Time, at 2 (Behar Decl., Feb. 13, 2008, Exh. D), granted by the TTAB in a communication dated Oct. 2, 2007. (Id. Exh. E.)


privilege or legitimate personal right that should be enforced to prevent the subpoenaed party from violating that privilege or right." (Id. (citations omitted).) That may be true in the usual subpoena to a third party situation, but the present situation is different.

Here, the complaint about the subpoenas is that they seek relief not permitted by the TTAB at this time.<sup>3</sup> Applicant has not suggested that the TTAB itself has any mechanism for providing a ruling on Opposer's position. Relief, rather, was properly sought in this Court. See 35 U.S.C. § 24.

Opposer's motion to quash the subpoenas is granted as to the subpoenas' document production provisions, but otherwise denied.

SO ORDERED.

Dated: February 21, 2008

  
\_\_\_\_\_  
Lawrence M. McKenna  
U.S.D.J.  
Part I

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<sup>3</sup> It does not appear that Applicant has sought to obtain a change in the TTAB schedule, which this Court does not have authority to grant.

# Exhibit B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE CHAMBER OF COMMERCE OF THE )  
UNITED STATES OF AMERICA, )  
Opposer, )  
vs. ) Opposition No.  
91-156,321  
Pages 1 - 94  
UNITED STATES HISPANIC CHAMBER )  
OF COMMERCE FOUNDATION, )  
Applicant. )

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DEPOSITION OF CURTIS CARLSON  
LOS ANGELES, CALIFORNIA  
MONDAY, FEBRUARY 25, 2008

REPORTED BY:  
LESLIE L. WHITE  
CSR NO. 4148  
JOB NO.: 15406

1 CURTIS CARLSON

2 BY MS. SLUSSER:

3 Q Going back to advertising, you testified that  
4 you advertise on your website, in newspapers in Sweden.  
5 Anywhere else?

6 A As the word "advertisement" is known in  
7 America, no. Now if you were to use the word  
8 "marketing" I could give you -- we market ourselves a  
9 lot under that logo and name.

10 Q Tell me how SACC-USA markets itself under the  
11 logo and name.

12 A Okay. This is -- the example I am going to  
13 give you is a very typical example. On the first page  
14 of Exhibit 4, you'll see something that says "Edays in  
15 San Diego."

16 Down in San Diego -- and by the way, the Edays  
17 in San Diego is in partnership with SACC-San Diego. But  
18 down there we will put advertisements in the paper down  
19 there for this Edays' event. In addition, well go to  
20 local development agencies and authorities, such as the  
21 San Diego County Development Authority. We'll go to the  
22 governor of California, which we have done for this  
23 event. We will go to other industry organizations, and  
24 just to narrow this, under the SACC -- under the Edays  
25 in San Diego, you'll see it says "Programs:



1 CURTIS CARLSON

2 Defense/Aerospace, Life Sciences, Media & Entertainment,  
3 Sustainable Energy, Wireless/Telecom, and venture  
4 Capital."

5 Whenever we hold an Edays, we narrow it down  
6 to certain clusters of businesses that will attract  
7 businesses that are in the general location of where the  
8 event is being held.

9 And so we got together and we said: What are  
10 the clusters of businesses that are around San Diego and  
11 Southern California, where it will induce people that  
12 are -- to attend. And we narrowed it down to these  
13 industries that I just listed.

14 So we will then go to those companies that are  
15 in these industries. We will also go to the industry  
16 organizations within these industries, and we will  
17 promote our event to them, using the brochures and all  
18 the stuff we have, and give him the Currents magazine  
19 and so on.

20 We'll also, as I say, go to the governor.  
21 We'll go to the development agencies and authorities for  
22 that purpose.

23 As part of our programs we also set up trade  
24 missions where we will have like a Development Authority  
25 for San Diego County, one for the State of California,

1 CURTIS CARLSON

2 go to Sweden. And if we were to do it now, we would  
3 promote these industries that are listed here under the  
4 Edays in San Diego.

5 Now recently we had an Edays in -- well, we  
6 had the one in Washington DC in 2005. Totally different  
7 cluster of businesses there. We were trying to get  
8 people to come from the Washington -- the Mid Atlantic  
9 and Washington area, but the same marketing effort went  
10 on.

11 Q So Edays in San Diego, is that an example of  
12 your Edays, I guess -- let me rephrase that question.

13 Do you do Edays across the country?

14 A Yes. In 2005 in Washington, DC. In 2007 we  
15 did it in Chicago. And in Chicago the main cluster was  
16 all around the auto industry, and the machinery  
17 industry. You know, they make ball bearings and things  
18 like that in the Chicago area. We were concentrating on  
19 that cluster of business.

20 Q You mentioned the Edays you held in 2005 in  
21 Washington, DC.

22 A Yes.

23 Q Where was that held?

24 A At the United States Chamber of Commerce  
25 headquarters. Gorgeous building across from Lafayette

1 CURTIS CARLSON

2 Park. Magnificent building, I got to tell you.

3 Q Did SACC-USA work in conjunction with the U.S.  
4 chamber for that event?

5 A Yes.

6 Q Can you describe how.

7 A Well, various -- in two ways. First, we  
8 needed a location, and so we had to sign an agreement  
9 with the United States Chamber of Commerce for them to  
10 allow to us use their facility for three days.

11 Secondly, because it was in Washington, DC,  
12 you know, we worked with the U.S. Chamber of Commerce to  
13 promote the event.

14 Q How did you promote the event?

15 A The same way -- in the same manner as I  
16 described how we have done it with respect to San Diego.  
17 We --

18 Q Go ahead.

19 A We got lists, we got, you know, we had people  
20 in these industries that we went to and invited them to  
21 attend, and, you know, people view our Edays as an  
22 opportunity to present their products and to make  
23 connections and, you know, it's a place to be, so to  
24 speak.

25 Q Were there any publications that went out for

1 CURTIS CARLSON

2 that Edays in Washington, DC?

3 A I don't remember if there were any articles in  
4 the paper. But afterwards we certainly promoted -- we  
5 promoted the event in our Currents magazine, both before  
6 and after.

7 Q Any brochures?

8 A I know there were brochures that were created  
9 ahead of time to promote the event. There is always  
10 brochures created specific for the event. And usually  
11 it's a three-fold or two-fold thing that folds into  
12 threes.

13 Q Was it published in any local magazines or  
14 newspapers?

15 A I don't know.

16 Q Do you know of any directories that it would  
17 be published in?

18 A Other than our own I don't know of any that it  
19 was published in.

20 Q Was the U.S. chamber associated with Edays,  
21 besides being the location?

22 MR. MERONE: Objection. Vague.

23 THE WITNESS: It is vague, but I'll try to answer  
24 it this way. They were not a partner in the event. By  
25 "partner" I mean they did not share in the profits or

1 CURTIS CARLSON

2 the losses. They -- I believe that we did get  
3 authorization to send information regarding this event  
4 to all the members of the United States Chamber of  
5 Commerce. And the Swedish-American chamber is a member  
6 of the United States Chamber of Commerce.

7 Let me put it differently. SACC-USA is a  
8 member of the United States Chamber of Commerce.

9 Q Was there anything else that the U.S. chamber  
10 did to help with Edays?

11 A I don't think so.

12 Q Were members of the U.S. Chamber of Commerce  
13 attending Edays?

14 MR. MERONE: I'm going to have a continuing  
15 objection at this point that for the past hour you have  
16 essentially been taking discovery. This is a trial  
17 deposition.

18 I'd refer you to Schedule A, which is the list  
19 of trial topics. You're not supposed to be taking this  
20 as an opportunity to conduct discovery. This has been a  
21 problem in all of our depositions.

22 We're going to have a continuing objection.  
23 You can keep going. I don't know the witness' schedule,  
24 but we have gone for an hour --

25 MS. SLUSSER: We'll also note for the record your

1 CURTIS CARLSON

2 Motion to Quash on the grounds that this is discovery  
3 was denied in the Eastern District of Virginia on  
4 Friday.

5 MR. MERONE: You are incorrect. It was declared to  
6 be moot because the Swedish-American Chambers of  
7 Commerce had already turned over the documents, and your  
8 associate stipulated in court that you were not going to  
9 seek any additional documents, and, therefore, as we had  
10 agreed, we would withdraw the motion because that action  
11 rendered it moot.

12 The only court that actually addressed the  
13 Subpoenas --

14 (Speaking simultaneously.)

15 MS. SLUSSER: I'll stop you right there --

16 MR. MERONE: Excuse me, I will finish because you  
17 brought up the action by the court. I'm going to  
18 clarify.

19 As I was saying, I have already spoken about  
20 Virginia. The only court to actually address some of  
21 the merits, in fact did quash the Subpoena Duces Tecum  
22 portion.

23 MS. SLUSSER: Moving on --

24 MR. MERONE: As to the testimony, we have not  
25 objected to the testimony. You're allowed to offer

1 CURTIS CARLSON

2 testimony, but it has to be confined to trial testimony  
3 and not an attempt to take discovery.

4 So now that you're taking discovery, I'm  
5 putting a continuing objection as to that. I would ask  
6 you to stick to Schedule A, which is the subject matter  
7 for the trial testimony.

8 MS. SLUSSER: Your objection is noted on the record  
9 now, and I will continue.

10 MR. MERONE: Thank you.

11 I think also you ought to check with the  
12 witness as to his schedule.

13 BY MS. SLUSSER:

14 Q Moving on --

15 A What was your last question?

16 Q We were just finishing up about the Edays held  
17 at the U.S. Chamber of Commerce in Washington, DC.

18 A Uh-huh.

19 MS. SLUSSER: Can you read my last question, I'm  
20 sorry.

21 (The record was read as follows:

22 "Q Were members of the U.S.  
23 Chamber of Commerce attending  
24 Edays?")

25 THE WITNESS: I don't know.

1 CURTIS CARLSON

2 BY MS. SLUSSER:

3 Q Thank you. For a clear record, I appreciate  
4 it.

5 A I was there, but I don't know if any members  
6 of the United States Chamber of Commerce were there.  
7 However, there would be a way to get the answer. It  
8 would require us to go back and dig out files that are  
9 in a warehouse, and we probably have them, you know, the  
10 names of the people that signed up -- probably have. I  
11 don't know if we have it for sure.

12 Q If you could look for that, I'd appreciate  
13 it --

14 A Uh-huh.

15 MR. MERONE: Excuse me. On the basis for looking  
16 for documents?

17 I want to know the basis that requests the  
18 witness to look for documents in connection with this  
19 case, since your testimony period closes on Thursday.

20 MS. SLUSSER: On the same basis that it is  
21 continuing with his trial testimony.

22 MR. MERONE: We continue our objection.

23 MS. SLUSSER: Okay.

24 Q Earlier we were talking about advertising and  
25 marketing. What is SACC-USA's annual advertising budget



1 CURTIS CARLSON

2 for the kind of advertisements we discussed earlier?

3 A I don't know the answer.

4 Q Is there a different marketing budget that you  
5 would know the answer?

6 A I know we have a line item for marketing.

7 (Telephonic interruption.)

8 THE WITNESS: Excuse me just a moment. Let me just  
9 reject this. I'll just reject it. Go ahead.

10 I know we have a line item on our budget for  
11 marketing budgeting. I don't remember what it is.

12 BY MS. SLUSSER:

13 Q Is there also a line item for advertising?

14 A I don't remember.

15 Q What territories are the -- what territories  
16 are brochures and the Currents magazines sent to?

17 A By "territories" what do you mean?

18 Q Where in the world are they sent?

19 A They are sent to every one of our 2500  
20 members, but in addition to that, we send copies of the  
21 magazine and the directory to a lot of people that  
22 aren't members.

23 By way of example, the governor of California  
24 is on our mailing list. The governor of Michigan is on  
25 our mailing list. The mayor of Rockford, Illinois is on

1 CURTIS CARLSON

2 our mailing list. And so we sent it to a lot of people,  
3 including development agencies in Arizona. And so the  
4 answer is virtually all 50 states.

5 In addition, we sent it throughout Sweden and  
6 other places in Europe.

7 Q Besides Edays, does the Swedish chamber  
8 organize conferences or seminars or workshops?

9 A Whenever we do we call it an Edays.

10 Q Okay. Do members of the Swedish chamber  
11 attend conferences or trade shows or conventions  
12 organized by other entities?

13 MR. MERONE: Objection. Outside the scope of the  
14 witness' knowledge. Outside of the 30(b)(6). Calls for  
15 testimony relating to third parties who are not here.

16 THE WITNESS: I have to go back to a prior answer.  
17 You need to know that all of our regional chambers are  
18 constantly holding conferences and seminars that they  
19 are not calling an Edays event.

20 So by way of example, SACC Minnesota will have  
21 a meeting on a monthly basis where they will be holding  
22 speakers and things like that present, and they will  
23 have -- they may have publicity in the paper as well.  
24 So all of our regional chambers are doing stuff on an  
25 ongoing basis.

CURTIS CARLSON

1

2 A Yes.

3 Q For example, the very first page says the  
4 Swedish-American Chamber of Commerce Arizona.

5 A Correct.

6 Q These are --

7 A They have already got the new logo, yeah.  
8 Yes, this is an example of Arizona. And Atlanta,  
9 et cetera.

10 Q I just have a few more questions, and then I'm  
11 ready to finish up.

12 A Uh-huh.

13 Q Were you contacted by the U.S. Chamber of  
14 Commerce lawyers about the Subpoena that you received?

15 A Yes.

16 Q When?

17 A I have something in my bag that would refresh  
18 my recollection.

19 It would have been on February 13, 2008.

20 Q Do you know the name of the person who  
21 contacted you?

22 A I am not a hundred percent certain whether it  
23 was Mr. Kane or Mr. Merone -- no? Mr. Kane, then.

24 (A discussion was held off the record.)

25 MS. SLUSSER: Back on the record.

CURTIS CARLSON

THE WITNESS: It would have been Mr. Kane.

BY MS. SLUSSER:

Q Did Mr. Kane call you?

A Yes. And he sent me a letter, both of which were received on February 13th.

Q Did you speak to him on the phone?

A Yes.

Q What did he say to you on the phone?

A He was just introducing himself. He asked if I received the materials. And the thing was that his phone call was around noontime or so, and I had received the materials, but I hadn't looked at them yet. So, you know, as I was on the phone, I was looking through the materials.

And he was very courteous and was explaining that a motion had been filed, and I'm free to read the motion and so on.

Q Was he talking about a Motion to Quash the Subpoena --

A Yes.

Q The documents in the Subpoena?

A Yes.

Q Did he tell you not to produce the documents that the Subpoena requested?

1 CURTIS CARLSON

2 A No, he did not. In fact, he wouldn't have  
3 been able to, because earlier that morning I had told my  
4 secretary to, you know, send them out, and they had  
5 already gone out by the time I got his phone call.

6 Q Did he tell you not to testify?

7 A No, he did not say anything of that sort.

8 Q What was your response when he asked you to  
9 read the Motion to Quash?

10 A He didn't ask me to. He invited me. It was  
11 up to me if I wanted to read it.

12 Q What was your response?

13 A I don't think I responded. But you know what,  
14 I did read it.

15 Q Did he indicate that there would be any  
16 repercussions from the U.S. chamber if you testified  
17 here today?

18 A No, absolutely not.

19 MR. MERONE: Objection. Lack of foundation.

20 THE WITNESS: In fact, I may have said to him, you  
21 know, "Our chamber enjoys a very good relationship with  
22 your chamber," and he said "And vice versa," or words to  
23 that effect. It was just a very friendly conversation.

24 BY MS. SLUSSER:

25 Q You are looking at a letter that was sent from

# Exhibit C

2 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
3 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X  
4 In Re Application Serial No. 78/081,731 for U.S.  
HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design

5 THE CHAMBER OF COMMERCE OF THE UNITED STATES OF  
6 AMERICA,

Opposer,

7  
vs.

Opposition No. 91-156,321

8  
9 UNITED STATES HISPANIC CHAMBER OF COMMERCE  
FOUNDATION,

10 Applicant.  
-----X

11  
12  
13 February 28, 2008  
12:00 p.m.

14  
15 \*\*\*\*\*ROUGH TRANSCRIPT\*\*\*\*\*

16 Deposition of MELISSA BROWN, pursuant  
17 to Subpoena, held at the offices of Manatt, Phelps  
18 & Phillips, LLP, 7 Times Square, New York, New  
19 York, pursuant to Subpoena, before Nicole  
20 Cannistraci, a Notary Public within and for the  
21 State of New York.

Untitled  
Melissa Brown - ROUGH TRANSCRIPT

A. Yes.

Q. What is the you URL or bright address?

A. WWW.SPAINUSCC.ORG.

Q. How does The Spain-U.S. Chamber use its web site?

A. Can you be more specific.

Q. What content does The Spain-U.S. Chamber place on its web site?

A. Our membership, up coming events, past events, photos.

A. Trade information, business listings. We include a copy of our publications there, we include information about the J1 visa there, and a resource center that includes frequently asked questions.

Q. On the web site and on those different section of the web site, do you use the name The Spain-U.S. Chamber of Commerce?

A. Yes.

Q. Do you visit the web site on a regular basis?

MS. SHEEHAN: Mark this as

Exhibit 6.

Elisa Dreier Reporting Corp. (212) 557-5558  
780 Third Avenue, New York, NY 10017

□

24

Melissa Brown - ROUGH TRANSCRIPT

(Printout from The

Spain-U.S. Chamber of Commerce Web  
Page 2



Untitled

4 site marked Exhibit 6 for  
5 identification.)  
6 Q. Have you seen this document  
7 before. Take your time to look at it. I know  
8 it's long?  
9 A. Yes.  
10 Q. Can you identify what it is?  
11 A. Yes.  
12 Q. What is it?  
13 A. It's a printout of The  
14 Spain-U.S. Chamber of Commerce web site.  
15 Q. In the seventh grouping of  
16 papers on the second page --  
17 A. Can you tell me the title of  
18 the seventh grouping just to make sure?  
19 Q. News and events overview. It  
20 has a photo?  
21 A. There we go.  
22 Q. On the second page does that  
23 page accurately reflect the events that The  
24 Spain-U.S. Chamber of Commerce offers?  
25 A. Can you be more specific?

Elisa Dreier Reporting Corp. (212) 557-5558  
780 Third Avenue, New York, NY 10017

□

25

1 Melissa Brown - ROUGH TRANSCRIPT  
2 Q. It lists networking,  
3 receptions, business luncheons, conferences and  
4 seminars, gala dinners, cultural gatherings.  
5 Are those examples of events that The Spain-U.S.

Untitled

6 Chamber of Commerce hosts?

7 A. Yes.

8 Q. Who attends those events?

9 A. Members of The Spain-U.S.

10 business community.

11 Q. Do nonmembers attend?

12 A. Yes.

13 Q. How do members and non members

14 find out about the events?

15 A. Primarily via e-mail. Also

16 they Mavis sit our Web site and occasionally we

17 may send out a mailing via post mail.

18 Q. What name is used when you send

19 out mailings about events, the organization?

20 A. What's the name of the

21 organization we use?

22 Q. That you put on the papers that

23 you mail to solicit people to come to the

24 events?

25 A. The Spain-U.S. Chamber of

Elisa Dreier Reporting Corp. (212) 557-5558  
780 Third Avenue, New York, NY 10017

□

26

1 Melissa Brown - ROUGH TRANSCRIPT

2 Commerce.

3 Q. The e-mail that is sent out to

4 promote the events, what would the e-mail

5 address be?

6 A. Events at Spain-U.S. CC.org.

7 Q. At these events, are there any

8 materials distributed to attendees?

Untitled

9 A. Occasionally.

10 Q. What name would be used on  
11 those printed materials?

12 A. It depends on the event.

13 Q. For the conferences what name  
14 would be used?

15 A. The sponsor.

16 Q. Who sponsors your events?

17 A. It depends on the events. You  
18 might want to look at a specific event.

19 Q. For the networking receptions,  
20 what name is used?

21 A. No materials is declined during  
22 networking receptions.

23 Q. Are there any displays or  
24 banners during the event?

25 A. Yes.

Elisa Dreier Reporting Corp. (212) 557-5558  
780 Third Avenue, New York, NY 10017

□

1 Melissa Brown - ROUGH TRANSCRIPT

2 A. It was delivered by a  
3 representative of Manatt, Phelps & Phillips.

4 Q. Was The Spain-U.S. Chamber  
5 contacted by the U.S. Chamber of Commerce?

6 A. No, I'm sorry, no, no, no,  
7 thank you for clarifying, no.

8 Q. By not -- not by the United  
9 States Chamber of Commerce's attorneys or by the  
10 United States Chamber itself? Either the United  
11 States Chamber of Commerce or its lawyers  
12 contacted The Spain-U.S. Chamber about the  
13 subpoena?

14 MR. DUNNING: Can I lend a  
15 hand here?

16 MS. SHEEHAN: Yes.

17 MR. DUNNING: What she wants  
18 to know is is your testimony that our  
19 Chamber was not contacted by the us  
20 Chamber itself and was it not  
21 contacted by the lawyers for the U.S.  
22 Chamber, two different things. When  
23 you answer your question are you  
24 saying they weren't contacted by  
25 either or by one and not the other?

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□

Untitled  
Melissa Brown - ROUGH TRANSCRIPT

THE WITNESS: Right. The Spain-U.S. Chamber of Commerce was not contacted by the U.S. Chamber of Commerce.

MR. DUNNING: What about by its lawyers? As far as you know.

THE WITNESS: As far as I know, we were.

MR. DUNNING: These are the lawyers for the Hispanic Chamber. (Indicating.)

THE WITNESS: You know what, I don't know, I'm not sure what came in.

Q. Okay. You didn't speak to anybody representing the United States Chamber of Commerce about testifying today?

A. Exactly.

MS. SHEEHAN: I'm just going to take a minute.

(An off the record discussion took place.)

BY MS. SHEEHAN:

Q. Is your testimony that for as

Elisa Dreier Reporting Corp. (212) 557-5558  
780 Third Avenue, New York, NY 10017

# Exhibit D

2

3 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
4 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

5 -----X  
6 In Re Application Serial No. 78/081,731 for U.S.  
7 HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design

8 THE CHAMBER OF COMMERCE OF THE UNITED STATES OF  
9 AMERICA,

10  
11 Opposer,

12 vs. Opposition No. 91-156,321

13 UNITED STATES HISPANIC CHAMBER OF COMMERCE  
14 FOUNDATION,

15 Applicant.

16 -----X

17

18 February 27, 2008  
19 12:00 p.m.

20

21 \*\*\*\*\*ROUGH TRANSCRIPT\*\*\*\*\*

22 Deposition of MARY GINNANE-SINGER,

23 pursuant to Subpoena, held at the offices of

24 Manatt, Phelps & Phillips, LLP, 7 Times Square,

25 New York, New York, pursuant to Subpoena, before

Nicole Cannistraci, a Notary Public within and for

the State of New York.

26

27

28

□

Untitled

2 and service providers so that they can promote  
3 their business in France and the United States.

4 Q. How is the FACC organized?

5 MR. ROSEN: Objection to  
6 form.

7 A. I don't understand.

8 Q. Are there chapters?

9 A. The French-American Chamber of  
10 Commerces that located in New York is a chapter  
11 per note that is.

12 Q. The chapter of what?

13 A. It's a chapter of a network of  
14 chapters of French-American Chambers of Commerce  
15 across the United States.

16 Q. How many Chambers across the  
17 United States are there?

18 A. There is 18 or so  
19 approximately. I don't know if that's an exact  
20 count.

21 Q. How many members does the FACC  
22 currently have?

23 A. How are you defining FACC?

24 Q. We have been talking about it  
25 as the entity that exists in New York.

□

18

1 Mary Ginnane-Singer ROUGH TRANSCRIPT

2 A. The FACC in New York has about  
3 650 members.

4 Q. How many members are there



5 across the United States combined?

6                   A.     They have approximately 3,500  
7     members.

8 Q. In the last five to six years  
9 has membership in the New York chapter changed  
10 appreciably?

11 MR. ROSEN: Objection to  
12 form.

13                   A.     I don't know what the numbers  
14                   were exactly over the past five or six years,  
15                   but I would -- to my knowledge, it's been -- it  
16                   has probably fluctuated a little bit based on  
17                   the economy, but it's been roughly the name.

18 Q. For the assist five to six  
19 years has the membership across the country  
20 changed appreciably?

21 MR. ROSEN: Objection to  
22 form.

23 A. I don't know.

24 Q. In 2002, what was the  
25 approximate membership for the New York chapter



19

1 Mary Ginnane-Singer ROUGH TRANSCRIPT  
2 of the FACC?

3 MR. ROSEN: Objection to  
4 form.

5                   A.     I don't know. I would have to  
6     look.

7 Q. Can you describe the FACC's

Untitled

8 members?

9 MR. ROSEN: Objection to the  
10 form.

11 A. What do you mean," describe  
12 "their members?

13 Q. Are they individuals?

14 A. They are individuals and  
15 businesses that are members.

16 Q. Approximately what percentage  
17 of the members are individuals?

18 A. I don't know.

19 Q. What kind of businesses are  
20 members?

21 MR. ROSEN: Objection to  
22 form.

23 A. They have many different types  
24 of businesses that are members. They share a  
25 common interest in French-American relations and

□

20

1 Mary Ginnane-Singer ROUGH TRANSCRIPT  
2 some are French companies, some are American  
3 companies.

1 Mary Ginnane-Singer ROUGH TRANSCRIPT

2 Q. Has FACC ever received checks  
3 or donations intended for the United States  
4 Chamber of Commerce?

5 A. No, not that I'm aware.

6 Q. Has FACC ever received  
7 complaints with that the name French-American  
8 Chamber of Commerce is confusing?

9 A. No, not that I'm aware of.

10 Q. Were you contacted by the  
11 United States Chamber of Commerce lawyers or the  
12 United States Chamber of Commerce about the  
13 subpoena?

14 A. I don't believe so. You mean  
15 was the Chamber of Commerce contacted?

16 Q. Yes.

17 A. No, I don't believe so.

18 Q. As far as you are aware, the  
19 FACC was not contacted by the United States  
20 Chamber of Commerce about your testifying today?

21 MR. ROSEN: Let me state here  
22 that there were communications  
23 between counsel for the FACC and  
24 counsel for the U.S. Chamber of  
25 Commerce. I was not a participant in

Untitled

1 Mary Ginnane-Singer ROUGH TRANSCRIPT

2 those communications, the written  
3 communications portion, prior to  
4 yesterday when I first spoke to you,  
5 Eric.

6 MR. KANE: I believe that's;  
7 correct.

8 MR. ROSEN: I don't know how  
9 the communications between the U.S.  
10 Chamber of Commerce and -- the  
11 counsel for the U.S. Chamber of  
12 Commerce and counsel for FACC was  
13 initiated. To the extent the witness  
14 knows have anything relating to those  
15 communications, those communications  
16 are going to be privileged. With  
17 that in mind, you can ask the  
18 question, but I don't know if the  
19 witness even knows the answer to  
20 that.

21 MS. SHEEHAN: That's fine.  
22 Just give me a minute and we may have  
23 a couple of additional questions.

24 (A recess was taken.)

25

# Exhibit E

**HELLRING LINDEMAN GOLDSTEIN & SIEGAL LLP**

**COUNSELLORS AT LAW**

BERNARD HELLRING (1916-1991)  
JOEL D. SIEGAL<sup>A</sup>  
JONATHAN L. GOLDSTEIN<sup>A</sup>  
MICHAEL EDELSON  
MARGARET DEE HELLRING<sup>A</sup>  
RICHARD D. SHAPIRO<sup>A</sup>  
CHARLES ORANSKY<sup>A</sup>  
RICHARD B. HONIG<sup>A</sup>  
RICHARD K. COPLON<sup>A</sup>  
ROBERT S. RAYMAR<sup>A</sup>  
RONNY J. G. SIEGAL<sup>A</sup>  
STEPHEN L. DREYFUSS<sup>A</sup>  
JOHN A. ADLER<sup>A</sup>  
JUDAH I. ELSTEIN<sup>A</sup>  
BRUCE S. ETTERMAN<sup>A</sup>  
MATTHEW E. MOLOSHOK<sup>A</sup>  
DAVID N. NARCISO<sup>A</sup>  
ROBERT B. ROSEN<sup>A</sup>  
SHERYL E. KOOMER  
PATRICIA A. STAIANO  
RONNIE F. LIEBOWITZ  
LISA P. PARKER  
CHRISTY L. SAALFELD<sup>A</sup>  
CHAMISE CARTER<sup>A</sup>  
ERIKA P. HANDLER  
JOSEPH H. TRINGALI

ONE GATEWAY CENTER  
NEWARK, NEW JERSEY 07102-5386  
(973) 621-9020

FAX (973) 621-7406  
www.hlgslaw.com

February 15, 2008

OF COUNSEL  
PHILIP LINDEMAN II<sup>A</sup>

**BY FAX AND FIRST-CLASS MAIL**

<sup>A</sup>NJ & NY

Andrew Eliseev, Esquire  
Manatt, Phelps & Phillips, LLP  
11355 W. Olympic Boulevard  
Los Angeles, California 90064

Re: Subpoena to French-American Chamber of  
Commerce in the United States

Dear Mr. Eliseev:

This firm represents the French-American Chamber of Commerce, Inc. ("FACC") with regard to a subpoena dated February 8, 2008 that you signed as attorney for the United States Hispanic Chamber of Commerce Foundation. Despite its date, the subpoena was not served on the FACC's office until the late afternoon of February 11, when it was delivered by ordinary messenger. This letter constitutes the FACC's written objection to the subpoena under Fed.R.Civ.P. 45(c)(2)(B).

The subpoena calls for the FACC to produce on February 22, 2008 --- only 11 days (including an intervening three-day holiday weekend) after service --- of an exhaustive list of items "from inception to present." In addition, it calls for the FACC to produce a witness to testify at a deposition on February 27, 2008 concerning an even more extensive list of topics --- some once again "from inception to present."

I understand that the underlying proceeding before the USPTO Trademark Trial and Appeal Board,

HELLRING LINDEMAN GOLDSTEIN & SIEGAL LLP

Andrew Eliseev, Esquire -2- February 15, 2008

between your client and the United States Chamber of Commerce ("U.S. Chamber"), involves your client's application for trademark protection for its name, the U.S. Chamber's opposition thereto, and a subsequent counterclaim by your client seeking cancellation of the U.S. Chamber's own trademark registrations on the ground that they are generic.

Your cover letter accompanying your subpoena to the FACC claims that "[t]o properly present its claims and defenses in this proceeding, [your client] needs to obtain testimony by a knowledgeable representative of the French American Chamber of Commerce in the United States ("FACC") relating to the nature and extent of the FACC's use of its name."

Obviously, the only similarity among the names of the U.S. Chamber of Commerce, the U.S. Hispanic Chamber of Commerce Foundation and the French-American Chamber of Commerce is the use of the words "Chamber of Commerce" in each. Yet both the FACC and the U.S. Chamber have disclaimed the exclusive right to use the words "Chamber of Commerce" apart from their marks. As a result, information concerning the FACC's use of its name and the myriad of document categories and deposition topics you have inserted in your subpoena can have no possible relevance to the underlying action.

Moreover, had you undertaken the slightest investigation before issuing this subpoena, you would have learned from the FACC's website that the FACC was founded in 1896. Your subpoena would require the FACC to review 112 years of operations and produce 112 years' worth of documents and deposition testimony in order to respond to your subpoena duces tecum and deposition testimony topics concerning

HELLRING LINDEMAN GOLDSTEIN & SIEGAL LLP

Andrew Eliseev, Esquire -3- February 15, 2008

(1) "the types of products and services that the FACC offers, sells or sold under, or bearing or promoted as or under, the FACC marks,"

(2) the FACC's "marketing and/or advertising" of its products and services,

(3) the "number and type of customers" and/or "the number of members of the FACC,"

(4) "the amount spent by the FACC to advertise or promote" its services "from inception to present,"

(5) "publicity relating to" the FACC's products and services, "including but not limited to, reviews, features, or mentions" of the FACC's products and services "in any medium and all press releases relating" thereto,

(6) "representative samples of documents and things reflecting the advertising, promotion, offering for sale, and/or sale" of the FACC's products and services, "including but not limited to, catalogs, advertisements, website pages, brochures, tradeshow materials, etc.,"

(7) "representative documents and things reflecting any publicity" relating to the FACC's products and services, "including but not limited to, press releases, articles, stories, or the like, featuring, mentioning, or reviewing" those products and services, and

(8) "representative samples of documents and things reflecting the geographic scope of FACC's use of" its trademarks.

The FACC is a not-for-profit corporation with a limited staff, and no ability to drop everything to review more than a century's worth of documents (many of which are in the hands of its former attorneys, the dissolved law firm Coudert Brothers, and not currently available to the FACC) in order to respond to an exhaustive document



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Andrew Eliseev, Esquire -4- February 15, 2008

demand within 11 days and produce a knowledgeable deponent within 16 days of service of the subpoena. The President of the FACC is currently in France, and will not return until the end of next week. His principal assistant with regard to FACC matters is currently away from the office for the holiday weekend and will not return until next Tuesday, February 19th.

I understand that the U.S. Chamber has filed a motion to quash the document portion of the subpoena, and that its motion is returnable before Part 1 of the United States District Court for the Southern District of New York on Tuesday, February 19th. It appears from the motion papers that the discovery period in the underlying action closed on June 1, 2006, and that the ad testificandum portion of your subpoena to the FACC must therefore be considered as a subpoena for trial testimony. It also appears that a closing date of February 28, 2008 for your client's trial testimony was established by a stipulated order of the TTAB on October 2, 2007 ---- more than four months before you served your exhaustive subpoena on the FACC (and similar subpoenas on many other binational chambers of commerce) requiring responses within 11 days of service.

As the attorney responsible for issuing and serving this subpoena, you had an affirmative duty to "take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena." Fed.R.Civ.P. 45(c)(1). Based on all of the facts and circumstances surrounding your subpoena to the FACC, it is indisputable that you have failed to fulfill that duty. In such circumstances, the mandate of Rule 45(c)(1) is clear:

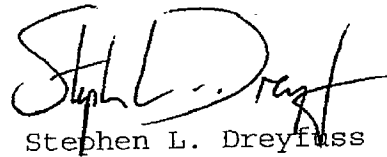
The issuing court must enforce this duty and impose an appropriate sanction --- which may include lost earnings and reasonable attorney's fees --- on a party or attorney who fails to comply.

HELLRING LINDEMAN GOLDSTEIN & SIEGAL LLP

Andrew Eliseev, Esquire -5- February 15, 2008

For the foregoing reasons, the FACC calls upon you to withdraw your subpoena in its entirety, both as to document production and deposition testimony. If you refuse to withdraw the subpoena, or if you move to compel production under Fed.R.Civ.P. 45(c)(2)(B)(i), the FACC reserves the right to take all action it deems appropriate to enforce its rights, including but not limited to seeking sanctions under Fed.R.Civ.P. 45(c)(1) and 28 U.S.C. § 1927.

Very truly yours,



Stephen L. Dreyfuss

SLD:dad

cc: Erik C. Kane, Esquire (by fax)

# Exhibit F

**ALEXANDER DUKOR & ASSOCIATES, P.C.****Attorney at Law**

1425 McHenry Rd., Suite 104, Buffalo Grove, IL 60089  
Tel(312)375-5560 Fax(847)883-0007

---

**FAX TRANSMISSION to 310.312.4224, 202.220.4201**

February 21, 2008

Mr. Andrew Eliseev  
Manatt, Phelps & Phillips, LLP  
11355 W. Olympic Boulevard,  
Los Angeles, CA 90064

CC: Mr. Erik C. Kane 202.220.4201

RE: Subpoena to American Russian Chamber of Commerce and  
Industry ("ARCCI").

Dear Mr. Eliseev,

I have left you the message on February 19, 2008 and I have not heard from you. I have also received the copy of the fax from Mr. Kane. The following is our response.

1. The subpoena was not served on ARCCI. There is no jurisdiction for service of subpoena on ARCCI in Washington DC. Rule 45(b)(2) allows service of subpoena: (A) within the district of the issuing court; (B) outside that district but within 100 miles of the place specified for the deposition, hearing, trial, production, or inspection; (C) within the state of the issuing court if a state statute or court rule allows service at that place of a subpoena issued by a state court of general jurisdiction sitting in the place specified for the deposition, hearing, trial, production, or inspection; or (D) that the court authorizes on motion and for good cause, if a federal statute so provides. ARCCI is registered in Illinois as a non-profit corporation and that is where its registered agent is located. Your representative delivered the subpoena to Regus located at 1101 Pennsylvania Avenue, NW, Washington DC. Regus is the company providing phone answering services and meetings rooms on request basis but it does not provide registered office address for ARCCI. ARCCI can use Regus as the place to hold meetings when its employees or officers are in Washington DC but

**ALEXANDER DUKOR & ASSOCIATES, P.C.****Attorney at Law**

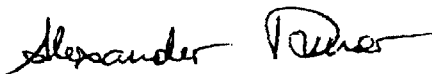
1425 McHenry Rd., Suite 104, Buffalo Grove, IL 60089  
Tel (312) 375-5560 Fax (847) 883-0007

---

it has no employees working at this address. Furthermore, when your representative brought the subpoena to Regus, the employee of Regus notified your representative that it can not and will not accept the subpoena on behalf of ARCCI. Your representative left it there anyway; however, it has not been accepted and has not been signed. I have attached the letter from Ms. Kelley Barnes, General Manager for Regus explaining why Regus can not accept any service of legal documents.

2. The subpoena if it would be served would place undue burden and expense on the small not-for-profit organization that is ARCCI in violation of Federal Civil Procedure Rule 45(3)(a)(iv). ARCCI does not keep archives and has no budget for producing large volume of documentation you are asking for. We are also in agreement with Mr. Kane that subpoena duces tecum was improper to the third party having no relationship whatsoever to the litigation in this case.
3. Finally, ARCCI officer would not be able to attend the deposition you have requested due to prior commitments.

Very Truly Yours,



Alexander Dukor, Esq.

AD/t1

Enclosure: Regus Letter.

The Regus logo, featuring the word "Regus" in a serif font with a small crown icon above the letter "i".

February 20, 2008

Helen Teplitskaia  
President  
American-Russian Chamber of Commerce & Industry  
Aon Center  
200 E. Randolph St., Suite 2200  
Chicago, IL 60601 USA

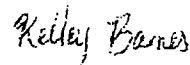
RE: Virtual Office Agreement/Non-Registered Agent

Dear Helen,

Per the terms and conditions of your Virtual Office Agreement with Regus White House (Evening Star), the service offerings entitle you to phone answering services and use of the center's business address. This service, however, does not entitle your firm to utilize the center as your registered office address. As such, Regus team members cannot act as a client's registered agent and are not permitted to serve on behalf of a client in matters requiring acceptance and signature on legal documents. Regus acknowledges that you do not have any employees that office out of our center address on a full time basis. In the above noted cases, we will make every attempt to notify you of such deliveries. If we are not able to reach you, the delivery will be rejected and serving agent asked to follow up at a later date.

For any additional questions, please feel free to contact me directly.

Kindest regards,

A handwritten signature in cursive script that reads "Kelley Barnes".

Kelley Barnes  
General Manager  
Regus White House (Evening Star)  
1101 Pennsylvania Avenue, NW  
5<sup>th</sup> - 7<sup>th</sup> Floors  
Washington, D.C. 20004  
T: (202)756-4593  
[Kelley.Barnes@regus.com](mailto:Kelley.Barnes@regus.com)

# Exhibit G

---

ERIK BERTIN

erik.bertin@dechert.com  
+1 202 261 3407 Direct  
+1 202 261 3107 Fax

February 22, 2008

**VIA EMAIL AND FACSIMILE**

Jill M. Pietrini  
Manatt, Phelps & Phillips, LLP  
11355 West Olympic Boulevard  
Los Angeles, CA 90064

Re: *The Chamber of Commerce of the United States of America v. United States  
Hispanic Chamber of Commerce* (Cancellation No. 92/045,876)

Dear Jill:

As you know, our firm represents the U.S. Mexico Chamber of Commerce.

I understand that you would like to depose our client as a non-party witness in this proceeding, and that the deposition is scheduled to take place at your offices in Washington, DC on February 25<sup>th</sup>. I also understand that you would like our client to produce certain documents in advance of this deposition.

You claim that you served our client with a subpoena on February 12<sup>th</sup>, and that this subpoena was accepted by Ms. Adriani Gil. As I mentioned over the phone, Ms. Gil is merely an intern, and as such, she is not authorized to accept service on behalf of the U.S. Mexico Chamber of Commerce. Moreover, I have been told that Ms. Gil has no recollection of having signed or received the subpoena that you describe.

Because your subpoena has not been properly served, our client has no obligation to appear for your deposition or to respond to your document requests. *See, e.g., Morfessis v. Marvin's Credit, Inc.*, 77 A.2d 178, 180 (D.C. 1950) (status as secretary and sole office employee did not establish agency to receive service of process for employer); *Larry M. Rosen & Associates, Inc. v. Hurwitz*, 465 A.2d 1114, 1117 (D.C. App. 1983) ("A receptionist in one's office, even if authorized to sign for and open all of the mail, is not necessarily authorized to accept service of process.").

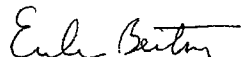


That having been said, the President of the U.S. Mexico Foundation Chamber of Commerce, Mr. Al Zapanta, would be willing to appear voluntarily for a testimonial deposition, subject to the following conditions:

- The deposition must be held at our offices in Washington, DC. Mr. Zapanta would be available on Wednesday, February 27<sup>th</sup> at 2:00 p.m., and it is my understanding that the deposition would last for roughly one hour.
- Because your subpoena has not been properly served, our client declines to produce the documents that you have requested. If you need additional information concerning the U.S. Mexico Chamber of Commerce, I invite you to visit our client's website, which is located at <http://www.usmcoc.org/>. I should also point out that counsel for the Petitioner in this case has filed a motion to quash your subpoena to the extent that it would require the U.S. Mexico Chamber of Commerce to produce certain documents, and as far as I know, the U.S. District Court has not yet ruled on this motion.

I will be in our Philadelphia office on Monday, but you can reach me via email or on my cell phone at (703) 585-3792. I look forward to hearing from you.

Sincerely,



Erik Bertin

cc: Erik C. Kane  
Kenyon & Kenyon LLP  
1500 K Street NW, Suite 700  
Washington, DC 20005-1257

# Exhibit H

# BAKER BOTTS LLP

THE WARNER  
1299 PENNSYLVANIA AVE., NW  
WASHINGTON, D.C.  
20004-2400

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WASHINGTON

February 21, 2008

Mr. Andrew Eliseev  
Manatt, Phelps & Phillips, LLP  
11355 West Olympic Boulevard  
Los Angeles, CA 90064-1614

Michael LiCalsi  
TEL +1 (202) 639-7763  
FAX +1 (202) 585-1014  
Michael.LiCalsi@BakerBotts.com

Dear Mr. Eliseev:

I respond on behalf of the United States-Azerbaijan Chamber of Commerce, Inc. ("USACC") to a subpoena dated February 8, 2008, issued by the United States-Hispanic Chamber of Commerce Foundation (the "Subpoena"). The Subpoena requests that the USACC produce documents by February 22, 2008, and that a representative of the USACC give deposition testimony on February 27, 2008. The USACC hereby objects to the terms of the Subpoena as noticed, and reserves all rights and defenses, including specifically sufficiency of service. Nonetheless, the USACC is willing to work with you to provide the information requested by the Subpoena on a reasonable schedule that is manageable for the USACC.

The USACC is a very small organization staffed by only one full time employee and three interns, all whom are currently overwhelmed by pressing business concerns – the most important of which is a February 28, 2008 publication deadline. Under such circumstances, the USACC is not able to produce responsive documents by the February 22, 2008 return date set forth in the Subpoena.

In addition, the individual who will testify on behalf of the USACC is traveling outside of the District of Columbia, and is unavailable to testify until the week of March 3, 2008. Accordingly, the USACC is not able to appear at the deposition noticed for February 27, 2008.

Please feel free to contact me to discuss a reasonable modification to the terms set forth in the Subpoena. If I do not hear from you by 5:00 p.m. (Eastern Standard Time). On Monday, February 25, 2008, I will assume that you agree to an extension of the deadlines set forth in the subpoena.

Sincerely,



Michael LiCalsi

# Exhibit I

**Kane, Erik**

---

**From:** Stephen M. Harnik [stephen@harnik.com]  
**Sent:** Thursday, February 21, 2008 7:21 PM  
**To:** Kane, Erik  
**Cc:** Ira A. Finkelstein; Eliseev, Andrew  
**Subject:** Subpoena in Opp. No. 91/156,321 USCC v. USHCC

Dear Mr. Kane:

We are the attorneys for the US Austrian Chamber of Commerce. Your letter of Feb. 13, 2008 addressed to our client together with your accompanying motion to quash returnable before the Part I Judge at the SDNY on Feb. 19, 2008 have been forwarded to us. Please let me know the status of the motion.

Thank you.

Stephen M. Harnik, Esq.  
Harnik Wilker & Finkelstein LLP  
Olympic Tower  
645 Fifth Avenue, 7th floor  
New York, NY 10022-5937  
Tel: (212) 599-7575  
Fax: (212) 867-8120  
e-mail: stephen@harnik.com

Visit us at our website: [www.harnik.com](http://www.harnik.com)

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3/12/2008

**Kane, Erik**

---

**From:** Stephen M. Harnik [stephen@harnik.com]  
**Sent:** Monday, February 25, 2008 5:50 PM  
**To:** sneal@manatt.com  
**Cc:** Eliseev, Andrew; JPHofer@aol.com; Kane, Erik; Ira A. Finkelstein  
**Subject:** The Chamber of Commerce of the USA v. US Hispanic Chamber of Commerce Foundation

Dear Mr. Neal:

I am in receipt of your letter of Feb. 21. Never having denied your subpoena, I am surprised by your trigger-happy threat of "contempt" proceedings. It would seem to have been incumbent upon you or Mr. Eliseev to have advised me of Judge McKenna's Memorandum and Order when I wrote you on Feb. 21, and not waited for this advice to come to me from Mr. Kane. In any event, I am under court order to appear in the southern district on February 28 at 9:30am in another pending matter, so we will need to re-schedule your deposition. Subject to my client's confirmation, I can tentatively offer Friday, Feb. 29, or Monday, March 3, both at 11am as alternate dates. Please check with Mr. Kane and come back to me.

Sincerely yours,

Stephen M. Harnik, Esq.  
Harnik Wilker & Finkelstein LLP  
Olympic Tower  
645 Fifth Avenue, 7th floor  
New York, NY 10022-5937  
Tel: (212) 599-7575  
Fax: (212) 867-8120  
e-mail: stephen@harnik.com

Visit us at our website: [www.harnik.com](http://www.harnik.com)

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3/12/2008

# Exhibit J

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Belgian-American Chamber of Commerce in the United States**, which is presently scheduled for February 27, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28<sup>th</sup> unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third party to appear for a deposition after the February 28<sup>th</sup> cut-off date, and will move to strike any late testimony taken voluntarily. To be sure, if the third party cannot attend on the scheduled date, we would be willing to attend the deposition on a different date, provided that all testimony is completed by February 28<sup>th</sup>. However, if the third party cannot attend at all prior to February 28<sup>th</sup>, we would submit that your inability to complete all of your testimony depositions within your proscribed testimony period (which opened last August) is a result of your not pursuing subpoenas until the end of your testimony period and would not provide a valid basis for extending time.

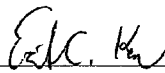




As we have already made arrangements to attend the deposition as noticed, and have not received any indications that the third party is unable to attend, we presume that the deposition will go forward as presently noticed. If you do not intend to take the deposition on the scheduled date and time, please let us know immediately. Should Applicant cancel the deposition only at the last moment and/or fail to attend, the U.S. Chamber will seek appropriate costs and attorney fees with the court that issued the subpoena to the extent permitted under Fed. R. Civ. Pro. 45.

Regards,

KENYON & KENYON LLP

  
\_\_\_\_\_  
Erik C. Kane

ECK

cc: The Belgian-American Chamber of Commerce in the United States (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S. – Azerbaijan Chamber of Commerce**, which is presently scheduled for February 27, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 (“A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.”).

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As we have already made arrangements to attend the deposition as noticed, and have not received any indications that the third party is unable to attend, we presume that the deposition will go forward as presently noticed. If you do not intend to take the deposition on the scheduled date and time, please let us know immediately. Should Applicant cancel the deposition only at the last moment and/or fail to attend, the U.S. Chamber will seek appropriate costs and attorney fees with the court that issued the subpoena to the extent permitted under Fed. R. Civ. Pro. 45.

Regards,

KENYON & KENYON LLP

---

Erik C. Kane

ECK

cc: The U.S. – Azerbaijan Chamber of Commerce (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Swedish – American Chambers of Commerce USA**, which is presently scheduled for February 25, 2008 in Los Angeles.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 (“A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.”).

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28<sup>th</sup> unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third party to appear for a deposition after the February 28<sup>th</sup> cut-off date, and will move to strike any late testimony taken voluntarily. To be sure, if the third party cannot attend on the scheduled date, we would be willing to attend the deposition on a different date, provided that all testimony is completed by February 28<sup>th</sup>. However, if the third party cannot attend at all prior to February 28<sup>th</sup>, we would submit that your inability to complete all of your testimony depositions within your proscribed testimony period (which opened last August) is a result of your not pursuing subpoenas until the end of your testimony period and would not provide a valid basis for extending time.



As we have already made arrangements to attend the deposition as noticed, and have not received any indications that the third party is unable to attend, we presume that the deposition will go forward as presently noticed. If you do not intend to take the deposition on the scheduled date and time, please let us know immediately. Should Applicant cancel the deposition only at the last moment and/or fail to attend, the U.S. Chamber will seek appropriate costs and attorney fees with the court that issued the subpoena to the extent permitted under Fed. R. Civ. Pro. 45.

Regards,

KENYON & KENYON LLP

\_\_\_\_\_  
Erik C. Kane

ECK

cc: The Swedish - American Chambers of Commerce USA (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Spain-U.S. Chamber of Commerce**, which is presently scheduled for February 28, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

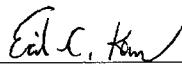
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Regards,

KENYON & KENYON LLP

  
\_\_\_\_\_  
Erik C. Kane

ECK

cc: The Spain-U.S. Chamber of Commerce (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S./Austrian Chamber of Commerce**, which is presently scheduled for February 28, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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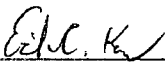




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Regards,

KENYON & KENYON LLP

  
\_\_\_\_\_  
Erik C. Kane

ECK

cc: The U.S./Austrian Chamber of Commerce (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The French American Chamber of Commerce in the United States**, which is presently scheduled for February 27, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Regards,

KENYON & KENYON LLP

---

Erik C. Kane

ECK

cc: The French American Chamber of Commerce in the United States (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Argentine-American Chamber of Commerce**, which is presently scheduled for February 27, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 (“A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.”).

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Regards,

KENYON & KENYON LLP

  
\_\_\_\_\_  
Erik C. Kane

ECK

cc: The Argentine-American Chamber of Commerce (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The American-Russian Chamber of Commerce & Industry**, which is presently scheduled for February 26, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 (“A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.”).

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Regards,

KENYON & KENYON LLP

\_\_\_\_\_  
Erik C. Kane

ECK

cc: The American-Russian Chamber of Commerce & Industry (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S. - Mexico Chamber of Commerce**, which is presently scheduled for February 25, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Regards,

KENYON & KENYON LLP

---

Erik C. Kane

ECK

cc: The U.S. - Mexico Chamber of Commerce (facsimile only)

February 19, 2008

**VIA FACSIMILE & EMAIL**

Jill M. Pietrini, Esq.  
Andrew Eliseev, Esq.  
MANATT, PHELPS & PHILLIPS L.P.  
11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S. – Women’s Chamber of Commerce**, which is presently scheduled for February 25, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28<sup>th</sup>, as scheduled. *Accord* TBMP §509.02 (“A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.”).

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Regards,

KENYON & KENYON LLP

---

Erik C. Kane

ECK

cc: The U.S. – Women's Chamber of Commerce (facsimile only)

# Exhibit K

**Kane, Erik**

**From:** Eliseev, Andrew [AEliseev@manatt.com]  
**Sent:** Friday, February 22, 2008 7:52 PM  
**To:** Colbert, Edward  
**Cc:** Pietrini, Jill; Kane, Erik; Merone, William  
**Subject:** RE: Deposition Schedule Changes

Dear Ed,

Several corrections to the table below:

The depositions of the U.S.-Mexico CoC and United States - Azerbaijan CoC will NOT go forward as scheduled; the deposition of the Spain - U.S. CoC WILL take place as scheduled.

If you attend depositions that do not take place because of the witnesses' failure to appear, you're not entitled to any costs and fees for the attendance.

If we learn of any changes to the schedule, we'll notify you as soon as possible.

Andrew

---

**From:** Colbert, Edward [mailto:EColbert@kenyon.com]  
**Sent:** Friday, February 22, 2008 6:15 PM  
**To:** Eliseev, Andrew  
**Cc:** Kane, Erik; Merone, William  
**Subject:** Deposition Schedule Changes

Dear Andrew:

I wanted to confirm the information you provided to me just before five p.m. today, at the close of the deposition of Mr. Nino. We went through the list of deposition noticed by the USHCC and you indicated to me whether the deposition definitely was not going to take place ("off"), definitely would take place ("on"), or it was still uncertain as to whether it would take place ("uncertain"). I have set out that information below.

Date	Time	Location	Name	
2/25/08	9:00a	DC	United States-Mexico CoC	UNCERTAIN
2/25/08	1:00p	DC	U.S.-Women's CoC	UNCERTAIN
2/25/08	9:00A	LA	Swedish-American CoC USA	ON
2/26/08	9:00a	DC	American-Russian CoC & Indus.	OFF
2/27/08	9:00a	DC	United States-Azerbaijan CoC	UNCERTAIN
2/27/08	9:00a	NY	French American CoC in the United States	OFF
2/27/08	12:00p	NY	Belgian-American CoC in the United States	UNCERTAIN
2/27/08	3:00p	NY	Argentine-American CoC	UNCERTAIN
2/28/08	9:00a	NY	U.S./Austrian CoC	UNCERTAIN
2/28/08	10:30a	Los Angeles, CA	Monica Danner	ON
2/28/08	12:00p	NY	Spain - U.S. CoC	UNCERTAIN

As the notes show, only two of the remaining eleven noticed depositions are still considered to be definite, both in Los

3/12/2008

Angeles. I just want to confirm that if we attend any depositions which do not take place, we will ask the court issuing the subpoena involved to award us both costs and fees for that attendance.

In this regard, I point out that it is now over an hour past the close of business on Friday the 22nd, and you still have not confirmed whether the depositions scheduled for D.C. to start at the opening of business on the next business day, Monday the 25th actually will still take place. If you do not inform me in sufficient time that I am able to be reached and informed of a cancellation, then I will attend. If I attend, and the deposition does not take place, we will ask for fees and costs. You may call me at the office or send me an email to reach me over the weekend. I shall endeavor, but cannot guarantee that I will see any left message, so please be diligent. I consider this the responsibility of the noticing party, not mine. I recommend that you copy both Erik Kane and Bill Merone on any email as they may be able to reach me, though it is not their responsibility either.

Please let us know as soon as possible.

Yours,

Ed Colbert

**Edward T. Colbert**  
**Kenyon & Kenyon LLP**  
1500 K Street, NW | Washington, DC 20005-1257  
202.220.4280 Phone | 202.220.4201 Fax  
ecolbert@kenyon.com | www.kenyon.com

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IRS CIRCULAR 230 DISCLOSURE: To comply with requirements imposed by recently issued treasury regulations, we inform you that any U.S. tax advice contained in this communication (including any attachments) is not intended or written by us, and cannot be used by you, for the purpose of (i) avoiding penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another person any transaction or matter addressed herein. For information about this legend, go to <http://www.manatt.com/circ230>

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3/12/2008

# Exhibit L

**Kane, Erik**

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**From:** Kane, Erik  
**Sent:** Tuesday, February 26, 2008 3:22 PM  
**To:** 'Eliseev, Andrew'  
**Cc:** Neal, Stephen; Merone, William; Colbert, Edward; 'Pietrini, Jill'  
**Subject:** RE: Third-Party Depositions  
**Importance:** High

Andrew,

I have tried to reach you over the telephone but cannot reach you in LA, DC, or NY. In response to your email below, you confirmed that the French American deposition was cancelled in an email to Ed. Your email below is the first email I have seen mentioning a potential rescheduling of the deposition. I hardly think less than 24 hours notice is sufficient. In any event, based on your previous representations that it was cancelled, I already made my travel plans to travel to NY tomorrow morning for the first scheduled deposition at 12p tomorrow (Belgian). I simply cannot be there in time for your newly scheduled 10:30a deposition. We have repeatedly asked for confirmation of any changes to the schedule so we can make appropriate travel arrangements. However, given that the Belgian, Argentine, and Austrian depositions are not going forward, I will be available for the French American deposition at one of those times. Please confirm which of those times works for you and the witness.

Regards,  
Erik

---

**From:** Eliseev, Andrew [mailto:AEliseev@manatt.com]  
**Sent:** Tuesday, February 26, 2008 2:56 PM  
**To:** Kane, Erik  
**Cc:** Neal, Stephen  
**Subject:** Third-Party Depositions

Erik,

I am confirming that the depositions of the Argentine-American Chamber of Commerce, the Belgian-American Chamber of Commerce in the United States, and the U.S./Austrian Chamber of Commerce will not go forward as scheduled.

Further, as the U.S.-Mexico Chamber of Commerce's (USMCC) counsel notified both parties in his February 22, 2008 letter, USMCC would be available for the deposition on February 27, 2008 at 2 p.m. at Dechert LLP's offices in Washington, DC. My colleague Steve Neal notified you this morning that we will take the USMCC's deposition at the time and place proposed by the USMCC's counsel. I am now once again confirming that the deposition of the USMCC will go forward, and the U.S. Chamber of Commerce is invited to attend.

Lastly, as I notified you and your colleagues earlier, the deposition of the French American Chamber of Commerce in the United States will not go forward as scheduled. Instead, it will take place on February 27, 2008 at 10:30 a.m. at the place specified in the subpoena.

Regards,

Andrew Eliseev  
Manatt, Phelps & Phillips, LLP  
11355 West Olympic Boulevard  
Los Angeles, CA 90064  
Tel. 310-312-4384  
Fax 310-996-6986

3/12/2008



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# Exhibit M



Erik C. Kane  
Direct 202.220.4294  
ekane@kenyon.com

1500 K Street, NW  
Washington, DC 20005-1257  
202.220.4200  
Fax 202.220.4201

February 14, 2008

**VIA FEDERAL EXPRESS**

The U.S. – Mexico Chamber of Commerce  
1300 Pennsylvania Avenue, NW  
Suite G -0003  
Washington, DC 20004  
Attn: Chief Legal Officer

Re: Subpoena in Opp. No. 91/156,321  
U.S. Chamber of Commerce v. U.S. Hispanic Chamber of  
Commerce Foundation

Dear Sir or Madam:

We represent the U.S. Chamber of Commerce in the above captioned proceeding. The U.S. Chamber would like convey its apologies that you have been brought into this case by its adversary. We do not believe that it was warranted or necessary.

We have moved to quash the subpoena served on you by the U.S. Hispanic Chamber of Commerce Foundation with respect to the production of documents. Enclosed please find a copy of the motion we filed with the court that issued the subpoena. It is our position that at least that portion of the subpoena that seeks the production of documents is improper.

You should, of course, rely on the advice of your own legal counsel regarding the subpoena, especially as relates to the demand that a witness appear to testify (which is separate from the request for documents). However, if you so choose, we would be happy to discuss the case with you. If you have any questions or concerns, please do not hesitate to contact us.

Very truly yours,

KENYON & KENYON LLP

By: 

Erik C. Kane

Enclosure



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Direct 202.220.4294  
ekane@kenyon.com

1500 K Street, NW  
Washington, DC 20005-1257  
202.220.4200  
Fax 202.220.4201

February 14, 2008

**VIA FEDERAL EXPRESS**

The U.S. – Women's Chamber of Commerce  
1200 G Street, N.W., Suite 800  
Washington, DC 20005  
Attn: Chief Legal Officer

Re: Subpoena in Opp. No. 91/156,321  
U.S. Chamber of Commerce v. U.S. Hispanic Chamber of  
Commerce Foundation

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Washington, DC 20005-1257  
202.220.4200  
Fax 202.220.4201

February 14, 2008

**VIA FEDERAL EXPRESS**

The American – Russian Chamber of Commerce & Industry  
1101 Pennsylvania Avenue, 6<sup>th</sup> Floor  
Washington, DC 20004  
Attn: Chief Legal Officer

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U.S. Chamber of Commerce v. U.S. Hispanic Chamber of  
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Enclosure